

Amendment Under 37 C.F.R. § 1.111  
Serial No. 10/019,669  
Sughrue Ref: A7705

## **REMARKS**

### ***Formal Matters***

As a preliminary matter, the Examiner has not acknowledge the claim for priority under 35 U.S.C. § 119(e) to provisional application No. 60/201,758, which was filed on May 5, 2000. Therefore, Applicant respectfully requests the Examiner to acknowledge the claim for domestic priority. In addition, Applicant has added a sentence to the beginning of the present application indicating the priority claim.

Applicant notes with appreciation that the Examiner has initialed and considered the references listed on the PTO/SB/08 form submitted with the Information Disclosure Statements on January 2, 2002 and August 14, 2003.

Claims 1-40 are all of the pending claims. Claims 1, 25, 31, 35, and 38 are independent claims.

### ***Restriction***

Claims 33, 34, 37, 39, and 40 have been withdrawn from consideration by the Examiner because they are directed to a non-elected invention.

Applicant has amended withdrawn claims 33 and 34 so that the language used in these claims is consistent with that of amended independent claim 31, discussed below.

Applicants thank the Examiner for indicating that claims claims 26-30 have been rejoined to the allowability of independent claim 25.

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***Claim Rejections Under 35 U.S.C. § 112***

Claims 31 and 32 are rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite.

First, the Examiner alleges that the preambles of claims 31 and 32 are inconsistent with the bodies of the claims. Therefore, Applicant has removed the recitation “insole” from the preamble of these claims in order to overcome this rejection.

Second, the Examiner alleges that it is not clear what structural limitations of claim 31 “are adaptable for treating a weight bearing area of a human foot. In response, Applicant directs the Examiner’s attention to the recitation that the insole assembly is adapted to treat an area of a human foot “by removing an oval area of at least one of the insole layers directly under the area to be treated.” As such, it is insole assembly having at least one of the insole layers with a removed oval area that treats the human foot.

Finally, the Examiner alleges that the phrase “the edges of the oval area lacks antecedent basis. Therefore, Applicant has deleted “the” from this phrase.

In view of these remarks and the amendment, Applicant respectfully requests the Examiner to withdraw the 35 U.S.C. § 112, second paragraph, rejection.

***Allowable Subject Matter***

Claims 25-30 have been indicated as allowed.

Claims 3, 6, 9, and 12-24 have been indicated as being allowable if rewritten in independent form including all of the recitations of the base claim and any intervening claims. Therefore, Applicant has rewritten claim 3 in independent form, as shown hereinabove.

***Claim Rejections Under 35 U.S.C. § 102 and §103***

**Claim 1**

Claims 1, 2, 4, 5, 7, 8, 10, and 11 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Darby, US 5,491,909, (“Darby ‘909”) in view of Darby, US 5,370,133 (“Darby ‘133”) and Grim, US 5,329,705.

With respect to independent claim 1, Applicant has amended independent claim 1 to recite that the insole layers are “separably removable, and the out sole circumferential counter prevents each of the plurality of insole layers from shifting within the out sole cavity.” Applicant respectfully submits that this amendment is fully supported in the original specification at least by the non-limiting embodiment shown in Figs. 3 and 4 and the discussion at page 6, para. 24 of the original specification. The claimed invention prevents the layered insoles from the shifting that occurs in conventional shoes.

The combination of Darby ‘909, Darby ‘133, and Grim does not teach or suggest all of the recitations of amended claim 1. For example, Grim’s upper resilient layer 66 and bladder 64 (made up of thin sheet urethane 92, cloth material 94, and foam layer 96) are not separably removable.

In addition, there is no suggestion or motivation to provide Grimm’s inner sole assembly 52 within Darby 133’s portion 16A of the walking sole (considered by the Examiner as the out sole circumferential counter), such that the out sole circumferential portion prevents each of the plurality of insole layers from shifting within the out sole cavity. Darby ‘133 merely teaches a thinner foam insole assembly 24 that is bonded to the top 28 of the outer sole 22. Darby ‘133 at

4:34-39. Grimm merely teaches an inner sole assembly 52 that is not prevented from shifting by an outsole circumferential counter.

As such, Applicant respectfully requests the Examiner to withdraw the rejection of claim 1. In addition, Applicant respectfully requests the Examiner to withdraw the rejections of dependent claims 2, 4, 5, 7, 8, 10, and 11 at least because of their dependency from claim 1.

Claim 31

Claim 31 is rejected under 35 U.S.C. § 102(b) as being anticipated by Boisvert et al., US 4,813,157. Claim 32 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Boisvert in view of Kellerman, US 5,799,414.

With respect to independent claim 31, Applicant has amended independent claim 31 to recite that the “the out sole circumferential counter prevents each of the plurality of separable insole layers from shifting within the out sole cavity.”

Applicant respectfully submits that Boisvert does not teaches or suggest all of the recitations of amended claim 31. For example, Boisvert does not disclose that the layers are provided in an out sole circumferential counter that prevents each of the plurality of separably removable insole layers from shifting within an out sole cavity.

In view of the above, Applicant respectfully request the Examiner to withdraw the rejection of claim 1.

In addition, Applicant requests the Examiner to withdraw the rejections of dependent claim 32 at least because of its dependency from claim 31 and because Kellerman (which the Examiner alleges as showing an opening with a skived edge) does not cure the deficiencies in

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Boisvert discussed above. Applicant also respectfully requests the Examiner to allow withdrawn dependent claims 33 and 34 at least because of their dependency from claim 31.

***Claims 35 and 38***

Claims 35, 36, and 38 are rejected under 35 U.S.C. §103 (a) as being allegedly clearly anticipated by Darby '133. Applicant respectfully traverses this rejection.

With respect to independent claim 35, it is the Examiner's position that the front edge 32 of Darby '133's boot portion 18, which seems to be at a position approximately 1/3 of the longitudinal length of the shoe (Darby '133 at Fig. 1), corresponds to the claimed "fitting marker".

However, the front edge 18 of Darby 133's boot portion 18 cannot correspond to the claimed "out sole" because there is no "circumferential counter portion attached to and extending upward circumferentially from the" boot portion 18. Instead, it is only the Darby '133's walking sole 16 that could be considered the out sole. This walking sole 16 of Darby '133 does not have a fitting marker provided on the side surface.

As such, Applicant respectfully requests the Examiner to withdraw the rejection of claim 35 and requests the Examiner to withdraw the rejections of dependent claim 36 at least because of its dependency from claim 35.

With respect to independent claim 38, Applicant has added the recitation that the out sole circumferential counter "extends upward circumferentially from the out sole assembly." In view of this amendment, Applicant respectfully requests the Examiner to withdraw the rejection of claim 38 for the same reason discussed above with respect to claim 35.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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**23373**

CUSTOMER NUMBER

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